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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,622

02/11/2004

Leonid A. Yegoshin

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09/27/2005

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EXAMINER

TSEGAYE, SABA

ART UNIT

PAPER NUMBER

2662

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,622

Applicant(s)

YEGOSHIN, LEONID A.

Examiner

Saba Tsegaye

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2662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/11/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 6-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,711,146. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 6-18 of the instant application merely broadens the scope of the claims 1-13 of the Patent by eliminating the elements and their functions of the claims. It has been held that the omission an element and its function is an obvious expedient if the remaining elements perform the same function as before. In *re Karlson*, 136 USPQ 184 (CCPA). Also note *Exparte Rainu*, 168 USPQ 375 (Bd.App. 1969)) omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Rautiola et al. (US 5,991,639).

Rautiola discloses, in Fig. 2, a mobile phone 10 and 14, a BTS 105, and a BSC 104 (claimed a first communication interface comprising circuitry for receiving and sending the audio data on a cell-phone network), sub-telephone systems 15, 16, 90, telecommunication servers 60, 61, and a data transfer network using nodes 70, 71 (claimed a second communication interface circuitry for connecting to a LAN, and for receiving and sending the audio data on the LAN). A mobile station 10 is connected over a wired network to a mobile communication-switching center (as claimed in claim 3). See column 5, lines 5-47.

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6. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Sainton et al. (6,134,453).

Sainton et al. discloses, in Fig 7, a telephone handset 710 including speaker 100 and microphone 102, and serves to allow for voice communication over radio network service providers (claimed microphone and speaker apparatus including converters for rendering audio data as audible speech, and for rendering audible speech as audio data). The microprocessor 110 in the Omni-modal circuit card 701 allows the circuitry to select either landline transmission via RJ-11 jack 712 (claimed a second communication interface) or cellular radio transmission through antennae 2 (claimed a first communication interface).

In addition, Sainton discloses, in Fig 12, a cellular radiotelephone 1200 is constructed using a modular omni-modal circuit 1 constructed on a removable card 1204 which is provided with a standardized connector (for example, a PCMCIA connector) 1205 to establish all necessary interface connections to a plurality of receiving devices in the manner described above.

7. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Kikinis (6,078,566).

Kikinis discloses, in Fig 2, a portable unit 100, a PC 152, LAN/WAN 500 and a transceiver 400. A speech system 104 contains the necessary components for enabling data network telephony DNT and IPNT telephony communication and doing necessary A/D and D/A conversion between digital voice-data and analog voice signals from a microphone 106, a speaker 105 (claimed microphone and speaker apparatus). RF interface 109 provides digital

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wireless interface with transceiver 400 (claimed a first communication interface) and the PC 152 communicate with unit 100 via infrared or other wired or wireless link (claimed a second communication interface).

Claim Rejections - 35 USC § 103

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautiola et al. in view of McCann et al. (US 6,052,725).

Rautiola shows all the claim limitations as indicated in the previous rejections. Further, Rautiola discloses a PSTN 110 and a server 90 (claimed a PSTN having a trunk connection to the IP telephony server). Claim 10 is described at column 16, lines 11-65. However, Rautiola does not show a wireless IP-LAN and a negotiation for a temporary IP address with the LAN.

McCann discloses, in Fig. 1, a communication device 16, a LAN 20 (claimed a wireless IP-LAN), a local protocol server (claimed an IP telephony server), and a local router 22. A dynamic IP address is assigned to the communication device 16 to enable communication between the communication device 16 and an IP network. The mobile device 16 is assigned a non-local dynamic IP address from a specific remote network. The local router 22 receives communications from the device 16 and from IP network 14 and determines the paths that communications should follow. See column 3, lines 44-65 and column 8, lines 5-32.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add an IP-LAN and an establishment of negotiation for a temporary IP address with the LAN to Rautiola et al., as taught by McCann et al. in order to access communication networks at the new temporary location and eliminating service request refusals.

Conclusion


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Peitz (US 5,412,760) discloses circuit arrangement for switched networks consisting of exchanges, preferably telephone networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saba Tsegaye whose telephone number is (571) 272-3091. The examiner can normally be reached on Monday-Friday (7:30-5:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ST
September 23, 2005


JOHN PEZZLO
PRIMARY EXAMINER